

REMARKS

In the Office Action mailed 12/10/2008, the Examiner has argued that “[t]he instant claims after [a]pplicant’s amendments filed 10/28/2008 continue to recite two embodiments” and has further suggested that “[a]pplicant further amend the claim language to reflect the above discussed distinction.” While applicant respectfully disagrees whether the independent claims recite two embodiments, in the spirit of expediting the prosecution of the present application, applicant has amended the independent claims as suggested by the Examiner.

The Examiner has rejected Claims 1-6, 8-10, 12-15, 23-27, 28-30, 32, 34, and 41-44 under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (U.S. Patent No. 6,901,519) in view of Alam et al. (U.S. Patent No. 6,336,124). In addition, the Examiner has rejected Claims 7 and 36-39 under 35 U.S.C. 103(a) as being unpatentable over Stewart, in view of Alam, and further in view of Schwabe et al. (U.S. Publication No. 2003/0028686). Applicant respectfully disagrees with such rejections.

With respect to the independent claims, the Examiner has relied on Col. 6, lines 9-32; Col. 2, lines 28-36; Col. 2; and Col. 20, lines 8-29, in addition to item 518 of Figure 6 from the Alam reference to make a prior art showing of applicant’s claimed technique “wherein it is determined when the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts in response to it being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type” (as amended – see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpts from Alam relied upon by the Examiner teach “[a] computer implemented method of converting a document in an input format to a document in a different output format,” where “[t]he method generally comprises locating data in the input document, grouping data into one or more intermediate format blocks in an intermediate format document, and converting the intermediate format document to the output format document using the intermediate format blocks” (Col. 2, lines 12-19 – emphasis added). Further, the excerpts teach that “[e]ach of the input format and output format may be in portable document format (PDF), rich text format (RTF), hypertext markup language (IITML), extensible markup language (XML), cascading style sheets (CSS), Netscape Layers, linked and separate pages, Tag Image File Format (TIFF), graphics interchange format (GIF), bit map (BMP), Joint Photographic Experts Group (JPEG), MICROSOFT WORD.TM., WORD PERFECT.TM., AUTOCAD.TM., and POWER POINT.TM.” (Col. 2, lines 29-37 – emphasis added).

However, converting a document in an input format to a document in a different output format by locating data in the input document, grouping data into one or more intermediate format blocks in an intermediate format document, and converting the intermediate format document to the output format document, where the input format and output format may be in PDF, RTF, HTML, XML, CSS, TIFF, GIF, BMP, or JPEG, as in Alam, simply fails to suggest applicant’s claimed technique “wherein it is determined when the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts in response to it being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type” (emphasis added), as claimed by applicant.

In addition, applicant asserts that the figure and excerpts relied on by the Examiner teach that “a text and/or image authoring tool 516 may be utilized to create a text and/or image document 518” and that “[t]ext/image document 518 is output to a document converter 528 which converts text and/or image document 518 to an intermediate format document 530” (Col. 6, lines 9-18 – emphasis added). Further, the excerpts teach that the “[i]ntermediate format document 530 is received by a converter 532 which converts intermediate format document 530 to an output format document 534” (Col. 6, lines 24-26 – emphasis added).

However, only generally teaching that a text and/or image authoring tool 516 is utilized to create a text and/or image document 518, where the text/image document 518 is output to a document converter 528 that converts the text and/or image document 518 to an intermediate format document 530, and where the intermediate format document 530 is received by a converter 532 which converts the intermediate format document 530 to an output format document 534, as in Alam, simply fails to suggest applicant’s claimed technique “wherein it is determined when the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts in response to it being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type” (emphasis added), as claimed by applicant.

Additionally, applicant asserts that the excerpts teach a “process 2500 for converting an input format document to an output format document,” where the “process 2500 includes receiving an input document over the network,” and “determin[ing] if the input document is in a supported format,” such that “[i]f the input document is not in a supported format, process 2500 ends” and that “[i]f the input document is in a supported format, the input document is converted to an intermediate format document at step 2510” (Col. 20, lines 8-27 – emphasis added).

However, the mere disclosure of determining if the input document is in a supported format, such that if the input document is in a supported format, the input document is converted to an intermediate format document, as in Alam, simply fails to suggest applicant's claimed technique "wherein it is determined when the first file format is one of a word processing file format type and a graphics file format type, the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts in response to it being determined that the first file format is the word processing file format type, the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type" (emphasis added), as claimed by applicant. Clearly, only generally determining if the input document is in a supported format, as in Alam, simply fails to specifically teach "the second file format being at least one of a TXT file format, a RTF file format without embedded objects, and a HTML file format without scripts in response to it being determined that the first file format is the word processing file format type" and that "the second file format being at least one of a JPB file format, a BMP file format, a GIF file format, a HTML file format without scripts, and a JPEG file format in response to it being determined that the first file format is the graphics file format type" (emphasis added), as specifically claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art excerpts, as relied upon by the Examiner, fail to teach or suggest all of the claim limitations, as noted above. Thus, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to dependent Claims 23 and 41-44, the Examiner has failed to provide a specific prior art showing of the subject matter of such claims. Applicant respectfully asserts that the Stewart and Alam references simply fail to disclose applicant's claimed "certain electronic file being an electronic file received by at least one of a RTP transfer or a HTTP transfer protocol" (Claim 23 – emphasis added), or applicant's claimed techniques "wherein said converting replaces formatting of the certain electronic file with new formatting to retain an original appearance of the certain electronic file" (Claim 41 – emphasis added), "wherein a notification indicating the certain electronic file represents a potential security risk is sent to the intended recipient in response to the determination that the certain electronic file represents at least the potential risk to the security of the computer system" (Claim 42 – emphasis added), "wherein a server computer forwards the converted electronic file to the intended recipient in response to a request to view the certain electronic file from the intended recipient" (Claim 43 – emphasis added), and "wherein a desktop computer of the intended recipient performs said converting of the infected electronic file to the second file format prior to the user opening the certain electronic file" (Claim 44 – emphasis added), as claimed by applicant.

Accordingly, a notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Again, since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or specific prior art showing of each of the foregoing

claim elements, in combination with the remaining claimed features, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P092).

Respectfully submitted,
Zilka-Kotab, PC

/KEVINZILKA/

Kevin J. Zilka
Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100